

REMARKS

Claims 1-29 are pending in the present application. Claims 1-21 and 23-28 stand rejected and claims 22 and 29 stand objected to. By virtue of this response, claims 1, 12, and 23 have been amended and claim 29 has been cancelled. Accordingly, claims 1-28 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Allowable Subject Matter

Claims 22 and 29 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants thank the Examiner for the indication of allowable subject matter. Independent claim 23 has been amended to include those features of claim 29 (and claim 29 has been cancelled). Accordingly, Applicants submit that claims 23-28 are now in condition for immediate allowance. Additionally, Applicants have amended independent claims 1 and 12 to include features similar to those of original claim 29, and submit that claims 1 and 12 (and claims depending therefrom) are now also in condition for immediate allowance.

Specification

The abstract of the disclosure stands objected to because the word “invention.” Additionally, the title should be deleted on the top of the abstract.

Applicants have amended the Abstract herein to delete the word “invention” as well as title from the abstract page. Applicants request the objection be withdrawn.

Claim Rejections under 35 U.S.C. 102(e)

Claims 1-7, 9, 11-15, 17, 19, 23, 25-26, and 28 stand rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (U.S. Pub. 20030137766 A1).

As indicated herein, Applicants have amended independent claims 1, 12, and 23 to include features similar to those of original claim 29, which was indicated to include allowable subject matter. In particular, claims 1, 12, and 23 are amended to recite that “the calibration mark comprises an optically detectable indicium.” For example, an optically detectable indicium may include calibration marks such as those shown in Figs. 4A-4F or other features associated with the storage library, e.g., as described in paragraph [0031] of the specification. Thus, this feature is supported by the specification and the claims as originally presented; accordingly, no new matter has been added.

Furthermore, Applicants note that the Examiner may be improperly relying on “inherency”, and/or reading limitations out of the claims, with regard to some portions of the rejection to claims 1, 12, and 23. For example, Claim 1 recites “determining a distance between the calibration mark and a reference position based on the shift in the detected calibration mark, the offset position, and a focal length associated with the at least one sensor used to detect the calibration mark.” (Emphasis added). The Examiner states in the rejection “...see section [0031], wherein the optical inherently covers focal length...” (Page 3 of the Office Action). The Examiner is clearly stretching under an inherency basis of the rejection and/or reading features out of the claim in this analysis. In particular, even if the optical sensor of Ellis has a focal length, this does not meet the features recited by claim 1 (i.e., determining a distance based, *inter alia*, on the focal length). Accordingly, the Examiner has not pointed to any disclosure or suggestion in Ellis that a distance measurement is based on a focal length of a sensor (by inherency or otherwise).

Accordingly, Applicants request withdrawal of the rejection and allowance of claims 1, 12, and 23 (and those claims depending therefrom).

Claim Rejections under 35 U.S.C. 103(a)

A. Claims 8, 10, 18, 20, 21, and 27 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ellis et al. '766' in view of Ellis (U.S. Pat. No. 5,237,468 A).

Claim 8, 10, 18, 20, 21, and 27 depend from claims 1, 12, and 23 respectively and are allowable over Ellis '766 for at least similar reasons discussed above. Accordingly, the rejection should be withdrawn.

B. Claims 16 and 24 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ellis et al. '66' in view of Ellis (U.S. Pat. No. 6,385,003).

Claim 16 and 24 depend from claims 12 and 23 respectively and are allowable over Ellis '766 for at least similar reasons discussed above. Accordingly, the rejection should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 249212025700. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: October 27, 2005

Respectfully submitted,

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